REMARKS

Claims 1-30 are pending in the present application. The Applicants have amended Claims 5, 11, 17, and 23 to correct claim dependencies, Claims 4, 10, 16 to correct antecedents, Claims 7 and 11 to correct internal inconsistencies. The Applicants have also amended Claims 6, 12, 18, and 24 to incorporate elements from 7, 11, 17, and 23, respectively. Marked up versions of the claims, showing all the changes relative to the previous version of the claims, are provided on separate pages at the end of this Response, in accordance with 37 CFR 1.121(c)(1)(ii). For the Examiner's convenience, the Applicant's have provided a clean set of claims, as amended, following this Response after the pages with the marked up versions of the amended claims.

The following rejections are at issue and are set forth by number in the order in which they are addressed:

1) Claims 5, 7-12, 17, and 23 are rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite (Office Action, paragraphs 1-4);
2) Claims 1-30 are rejected under the judicially created doctrine of obviousness-type double patenting over claims 9-16 of U.S. Patent No. 6,015,833 in view of Cook et al. , U.S. Patent No. 5,760,082 (Office Action, paragraphs 5-6); and
3) Claims 1-30 are rejected under 35 U.S.C. §103(a), as allegedly obvious over Cook et al. (U.S. Patent No. 5,760,082) in view of Lievense et al. (U.S. Patent No. 6,159,525) and Baltes et al. (U.S. Patent No. 3,162,658) (Office Action, paragraphs 7-11 and following).

Applicants believe the present amendments and following remarks traverse the Examiner's rejection of the Claims.

1. The Claims Are Not Indefinite.

Claims 5, 7-12, 17, and 23 are rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite. The Examiner asserts that for Clams 5, 11, 17 and 23, there is insufficient antecedent basis for the limitation "said antioxidant." The Applicants thank the Examiner for pointing out this error, and have corrected the claims to depend from a claim in

which the antecedent "antioxidant" appears. The Examiner also asserts that Claim 7 is indefinite as to how to provide (or produce) the ester in the food product. The Applicants thank the Examiner for pointing out this discrepancy, and have amended the claim by deleting the word "ester" from the preamble, thereby rendering the claim internally consistent. For these reaons, Claims 5, 7-12, 17, and 23 as amended are not indefinite, and the Applicants respectfully request that the rejection of these claims be withdrawn.

2. The Claims are Not Obvious

Obviousness-type Double Patenting

Claims 1-30 are rejected under the judicially created doctrine of obviousness-type double patenting over claims 9-16 of U.S. Patent No. 6,015,833 ("the '833 patent) in view of Cook et al., U.S. Patent No. 5,760,082. The Examiner asserts that the '833 patent claims a food product containing conjugated linoleic acid, and that Cook et al. teaches that the derivative of conjugated linoleic acid, including esters, are similarly useful as the free acid in food products (Office Action, page 3).

However, the doctrine of obviousness-type double patenting requires that there be a common relationship of **inventorship** and/or **ownership** of two or more patents or applications (see MPEP § 804). Moreover, since the doctrine seeks to avoid unjustly extending patent rights at the expense of the public, the focus of any double patenting analysis is necessarily on the **claims** in the multiple patents or patent applications involved in the analysis (see MPEP § 804). Since the Cook et al. does not have either inventorship or ownership in common with the present application, this doctrine cannot apply. Moreover, the Examiner combined the **disclosure** in Cook et al. with the **claims** of the '833 patent, which is an incorrect analysis under the doctrine. Therefore, the Applicants respectfully request that the rejection of the claims on this basis be withdrawn.

Obviousness

Claims 1-30 are rejected under 35 U.S.C. §103(a), as allegedly obvious over Cook et al. (U.S. Patent No. 5,760,082) in view of Lievense et al. (U.S. Patent No. 6,159,525) and Baltes et al. (U.S. Patent No. 3,162,658). The Examiner asserts that Cook et al. teaches a

food product containing conjugated linoleic acids, their esters, salts or mixtures, that the linoleic acid compounds may be from corn oil, safflower, etc, that the food products may further contain vitamins, and that conjugated linoleic acid may be incorporated into various food products (Office Action page 3). The Examiner further asserts that Lievense et al teaches that Vitamin E is known to be useful in food product containing conjugated linoleic acid compounds (Office Action page 4). Finally, the Examiner asserts that Baltes teaches that isomerization of linoleic acid compunds by alcoholate catalysts is well known (Office Action page 4). The Examiner then concludes that it would be obvious to incorporate linoleic acid derivatives, including esters, as well as Vitamin E or alcohol in a food product (Office Action page 4).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (MPEP § 2143). Failure to establish **any one** of the these three requirements precludes a finding of a *prima facie* case of obviousness, and, without more, entitles an Applicant to allowance of the claims in issue. *See, e.g., Northern Telecom Inc. v. Datapoint Corp.*, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990). The Applicants submit that the Examiner has not met all three prongs for even one of the pending claims, and therefore respectfully request that the rejection of the claims as obvious be withdrawn.

The Applicants point out that the FIRST requirement is a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. The Examiner, however, is improperly considering these references collectively **before** establishing the threshold requirement that a person skilled in the art would be motivated to combine these references in the first place. The Applicants submit that the references **cannot** be considered collectively **until** the Examiner points to some motivation to combine these references. The purpose of this threshold requirement is to prevent the Examiner from using the invention itself and hindsight reconstruction to defeat the patentability of the invention.

The Examiner simply cites three references which appear to disclose different aspects of the claimed inventions, and then concludes that it is therefore obvious to combine them. However, the mere fact that references can be combined or modified (and the cited references cannot) does not render the resultant combination obvious unless the prior art suggests the desirability of doing so. (MPEP § 2143.01, citing to *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Baltes describes a method of alcoholate catalysis for producing conjugated linoleic acids; the products are described as "valuable industrial products" for use in formation of "light colored polymers," for use as "ingredients of lacquers or coating compositions" or as "ingredents of plascticizers" and as "reaction components in the preparation of resins" (Column 9, lines 47-60). Both Cook and Lievense describe production of conjugated linoleic acids by using KOH or NaOH and ethylene glycol (see, for example, column 2, lines 20-27 and column 5, lines 38-46, respectively). There is NO suggestion in any of the references, nor anywhere else outside of the Applicants' specification, of a **method** for producing a food product containing conjugated linoleic acid products comprising providing conjugated linoleic acid products which are obtained from or derived from conjugated linoleic acid esters produced by treating linoleic acid esters with an alcoholate catalyst, as is claimed in the present invention. Since independent Claims 1, 7, 13, and 19 are directed to such subject matter, these claims are not obvious over the cited references; therefore, claims depending from these indepent claims, Claims 2-5, 7-10, 13-17, and 20-23, are also not obvious over the cited references (MPEP § 2143.03).

Moreover, even the combination of the cited references does not teach all the claim limitations. Although the Examiner asserts that vitamins, and in particular vitamin E, are known to be useful along with conjugated linoleic acid compounds in food products, of the cited references only Lievense refers specifically to vitamin E, and it is in reference to the fat phase of an edible fat spread, which the reference states "may comprise...small amounts of other ingredients, e.g. emulsifier, colourant, flavour, vitamins, e.g. vitamin E, etc." (column 5, lines 3-5). None of the references teach or even suggest adding **antioxidants** to food products containing conjugated linoleic acid products, much less specific antioxidants lecithin, ascorbylpalmitate, and BHT, as does the claimed invention. Therefore, the cited references do not teach the elements of Claims 6, 12, 18, and 24, and these claims are not obvious over these references. Moreover, none of the references teach or even suggest a food product

comprising a conjugated linoleic acid moiety and an **alcohol**, as does the claimed invention, nor does the Examiner assert that they do. The Examiner simply concludes that the "employment of alcohol herein is seen to employment of a known food ingredient to a food product and therefore is obvious" (Office Action page 4). Thus, the references even in combination do not teach all of the elements of Claim 25, and thus do not teach all of the elements in its dependent Claims 26-30. Therefore, these claims are not obvious over the cited references as well.

For these reasons, Claims 1-30 are not obvious over the cited references, and the Applicants respectfully request withdrawal of the rejections of these claims.

CONCLUSION

All grounds of rejection of the Office Action of February 27, 2001 having been addressed, reconsideration of the application is respectfully requested. It is respectfully submitted that the invention as claimed fully meets all requirements and that the claims are worthy of allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Examiner is encouraged to call Mitchell Jones collect at (608) 218-6900.

Dated: May 8, 2001

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VERSION WITH MARKINGS TO SHOW CHANGES MADE
in accordance with 37 CFR 1.121(c)(1)(ii)

IN THE CLAIMS:

The following claims have been amended as shown:

4. (Amended Once) The method of Claim 1, further comprising providing an antioxidant and combining said antioxidant with said conjugated linoleic acid esters and said foodstuff in step [(c)] (b) to produce said food product.

5. (Amended Once) The method of Claim [1] 4, wherein said antioxidant is selected from the group consisting of α-tocopherol, β-tocopherol, lecithin, ascorbylpalmitate, and BHT.

6. (Amended Once) The food product produced according to the method of Claim 1, further comprising an oxidant selected from the group consisting of lecithin, ascorbylpalmitate, and BHT.

7. (Amended Once) A method for producing a food product containing conjugated linoleic acid [esters] comprising:

a) providing:

i) conjugated linoleic acid, wherein said conjugated linoleic acid is derived from conjugated linoleic acid esters produced by treating linoleic acid esters with an alcoholate catalyst; and

ii) a foodstuff; and

b) combining said foodstuff with said conjugated linoleic acid to produce a food product.

10. (Amended Once) The method of Claim 7, further comprising providing an antioxidant and combining said antioxidant with said conjugated linoleic acid and said foodstuff in step [(c)] (b) to produce said food product.

11. (Amended Once) The method of Claim [7] 10, wherein said antioxidant is selected from the group consisting of α-tocopherol, β-tocopherol, lecithin, ascorbylpalmitate, and BHT.

12. (Amended once) The food product produced according to the method of Claim 7, further comprising an oxidant selected from the group consisting of lecithin, ascorbylpalmitate, and BHT.

16. (Amended Once) The method of Claim 13, further comprising providing an antioxidant and combining said antioxidant with said triglycerides and said foodstuff in step [(c)] (b) to produce said food product.

17. (Amended Once) The method of Claim [13] 16, wherein said antioxidant is selected from the group consisting of α-tocopherol, β-tocopherol, lecithin, ascorbylpalmitate, and BHT.

18. (Amended Once) The food product produced according to the method of Claim 13 , further comprising an oxidant selected from the group consisting of lecithin, ascorbylpalmitate, and BHT.

19. (Amended Once) A method for producing a food product comprising:

a) providing:

i) linoleic acid esters;

ii) an alcoholate catalyst; and

iii) a foodstuff;

b) producing a conjugated linoleic acid esters by treating said [oil containing conjugated linoleic acid] linoleic acid esters with said alcoholate catalyst; and

c) combining said conjugated linoleic acid esters with said foodstuff to produce a food product.

23. (Amended Once) The method of Claim [19] 22, wherein said antioxidant is selected from the group consisting of α-tocopherol, β-tocopherol, lecithin, ascorbylpalmitate, and BHT.

24. (Amended Once) The food product produced according to the method of Claim 19, further comprising an oxidant selected from the group consisting of lecithin, ascorbylpalmitate, and BHT.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Asgeir Saebo *et al.*
Serial No.: 09/544,084 Group No.: 1617
Filed: 04/06/00 Examiner: Wang, S.
Entitled: **CONJUGATED LINOLEIC ACID COMPOSITIONS**

CLEAN COPY FOR EXAMINER'S CONVENIENCE ONLY

PENDING CLAIMS
(filed 05/07/01 in Response to Office Action mailed February 27, 2001)

1. A method for producing a food product containing conjugated linoleic acid esters comprising:

a) providing:

i) conjugated linoleic acid esters, wherein said esters are produced by treating linoleic acid esters with an alcoholate catalyst; and

ii) a foodstuff; and

b) combining said foodstuff with said conjugated linoleic acid esters to produce a food product.

2. The method of Claim 1, wherein said linoleic acid esters are derived from oils selected from the group consisting of safflower, sunflower, and corn oil.

3. The method of Claim 1, wherein said alcoholate catalyst is selected from the group consisting of sodium methylate and potassium methylate.

4. (Amended Once) The method of Claim 1, further comprising providing an antioxidant and combining said antioxidant with said conjugated linoleic acid esters and said foodstuff in step (b) to produce said food product.

5. (Amended Once) The method of Claim 4, wherein said antioxidant is selected from the group consisting of α-tocopherol, β-tocopherol, lecithin, ascorbylpalmitate, and BHT.

6. (Amended Once) The food product produced according to the method of Claim 1, further comprising an oxidant selected from the group consisting of lecithin, ascorbylpalmitate, and BHT.

7. (Amended Once) A method for producing a food product containing conjugated linoleic acid comprising:

a) providing:

i) conjugated linoleic acid, wherein said conjugated linoleic acid is derived from conjugated linoleic acid esters produced by treating linoleic acid esters with an alcoholate catalyst; and

ii) a foodstuff; and

b) combining said foodstuff with said conjugated linoleic acid to produce a food product.

8. The method of Claim 7, wherein said linoleic acid esters are derived from oils selected from the group consisting of safflower, sunflower, and corn oil.

9. The method of Claim 7, wherein said alcoholate catalyst is selected from the group consisting of sodium methylate and potassium methylate.

10. (Amended Once) The method of Claim 7, further comprising providing an antioxidant and combining said antioxidant with said conjugated linoleic acid and said foodstuff in step (b) to produce said food product.

11. (Amended Once) The method of Claim 10, wherein said antioxidant is selected from the group consisting of α-tocopherol, β-tocopherol, lecithin, ascorbylpalmitate, and BHT.

12. (Amended once) The food product produced according to the method of Claim 7, further comprising an oxidant selected from the group consisting of lecithin, ascorbylpalmitate, and BHT.

13. A method for producing a food product containing conjugated linoleic acid triglycerides comprising:

a) providing:

i) triglycerides containing conjugated linoleic acid moieties, wherein said conjugated linoleic acid moieties are derived from conjugated linoleic acid esters produced by treating linoleic acid esters with an alcoholate catalyst; and

ii) a foodstuff; and

b) combining said foodstuff with said triglyerides containing conjugated linoleic acid moieties to produce a food product.

14. The method of Claim 13, wherein said linoleic acid esters are derived from oils selected from the group consisting of safflower, sunflower, and corn oil.

15. The method of Claim 13, wherein said alcoholate catalyst is selected from the group consisting of sodium methylate and potassium methylate.

16. (Amended Once) The method of Claim 13, further comprising providing an antioxidant and combining said antioxidant with said triglycerides and said foodstuff in step (b) to produce said food product.

17. (Amended Once) The method of Claim 16, wherein said antioxidant is selected from the group consisting of α-tocopherol, β-tocopherol, lecithin, ascorbylpalmitate, and BHT.

18. (Amended Once) The food product produced according to the method of Claim 13 , further comprising an oxidant selected from the group consisting of lecithin, ascorbylpalmitate, and BHT.

19. (Amended Once) A method for producing a food product comprising:

a) providing:

i) linoleic acid esters;

ii) an alcoholate catalyst; and

iii) a foodstuff;

b) producing a conjugated linoleic acid esters by treating said linoleic acid esters with said alcoholate catalyst; and

c) combining said conjugated linoleic acid esters with said foodstuff to produce a food product.

20. The method of Claim 19, wherein said linoleic acid esters are derived from oils selected from the group consisting of safflower, sunflower, and corn oil.

21. The method of Claim 19, wherein said alcoholate catalyst is selected from sodium methylate and potassium methylate.

22. The method of Claim 19, further comprising providing an antioxidant and combining said antioxidant with said conjugated linoleic acid esters and said foodstuff in step (c) to produce said food product.

23. (Amended Once) The method of Claim 22, wherein said antioxidant is selected from the group consisting of α-tocopherol, β-tocopherol, lecithin, ascorbylpalmitate, and BHT.

24. (Amended Once) The food product produced according to the method of Claim 19, further comprising an oxidant selected from the group consisting of lecithin, ascorbylpalmitate, and BHT.

25. A food product comprising a conjugated linoleic acid moiety and an alcohol.

26. The food product of Claim 25, wherein said alcohol is ethyl alcohol.

27. The food product of Claim 25, wherein said alcohol is present in a concentration of about less than 10 ppm.

28. The food product of Claim 25, wherein said conjugated linoleic acid moiety is an ester of conjugated linoleic acid.

29. The food product of Claim 25, wherein said conjugated linoleic acid moiety is a free fatty acid.

30. The food product of Claim 25, wherein said conjugated linoleic acid moiety is a triglyceride.